

REMARKS

Claims 1-7 are pending in the present application.

I. PRIOR ART REJECTION

Claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,201 (Tso). This rejection is traversed.

The Examiner's reasoning presented in paragraph 2 of the Final Office Action is substantially similar to that presented in the previous Office Action dated March 25, 2004. One difference is the addition of several arguments on paragraph 3 of the Final Office Action in response to Applicant's Remarks presented in the amendment filed on June 25, 2004. In these additional arguments, the Examiner asserts that the reply e-mail of Tso includes at least one or more portions of the received e-mail. Specifically, the Examiner argues:

Tso teaches of 'context appropriate sentences to include in the outgoing text message **based on** the actual content of the input text passage' (see col. 2, lines 65-67), wherein the input text passage can be '[a] portion of a received text message' (see col. 2, lines 61-64). (Emphasis Added).

In presenting these quoted passages of Tso, the Examiner has left out a critical portion of this quoted section of Tso, and rearranges some of the phrases of this quoted section of Tso which mischaracterizes the true meaning. In fact, when the entire text of this quoted section of Tso is examined, it is clear that this section shows unequivocally that Tso does not anticipate the claimed invention. The entire portion of this section of Tso is reproduced below.

Given an input text passage, such as a portion of a partially-compressed outgoing text message, the template engine can suggest one or more **predefined**, context-appropriate sentences to include in the outgoing text message **based upon** the actual content of the input text passage. (emphasis added).

The key phrase in this portion of Tso quoted by the Examiner is the phrase “based upon” and “predefined.” When considering the entire portion of this quote, it is clear that the template engine suggests **predefined** context-appropriate sentences **based upon** the actual content of the input text passage. That is, Tso does not use **portions** of the received e-mail in the reply e-mail, as in the claimed invention. Rather, Tso teaches that the template suggests predefined text **based upon** the input text message. The fact that the context-appropriate sentences are **predefined** means that portions of the received e-mail are

not used in the reply e-mail, since the received e-mail cannot be known before hand.

In paragraph 3 of the Final Office Action, the Examiner also asserts:

Therefore, it is inherent by the teachings of Tso, for example, if an e-mail message was received such as "Can we meet at Joe's Diner at 12:00?", the teachings of Tso would suggest "Yes we can" or "No we cannot" "meet at Joe's Diner at 12:00.

Applicant submits that the Examiner has mischaracterized the teaching of Tso. The information presented in the above quotation by the Examiner is not contained in Tso. Rather, this information is a hypothetical example created by the Examiner. Thus, this example cited by the Examiner is completely irrelevant to the issue of anticipation by Tso.

In paragraph 3, the Examiner further asserts:

The teachings of Tso do not teach away from the claimed invention and clearly do not suggest portions of a received e-mail cannot be included or inserted in the outgoing "context-appropriate sentences" message.

Applicant submits that the Examiner cannot show anticipation by a prior art reference simply asserting that the prior art reference does not teach away from a claimed invention. Rather, in order to establish a prima facie case of anticipation, the Examiner must positively show that each and every claim feature is disclosed in the prior art reference. As presented above, Tso does not teach or suggest several portions of the claimed invention. Therefore, Tso does not anticipate claims 1-7. Thus, the rejection of claims 1-7 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

This section of Tso emphasized by the Examiner teaches that additional templates are selected based on additional text selected by the user. Therefore, Tso does not anticipate claims 1-7.

The sections of Tso relied on by the Examiner do not teach or suggest to use portions of the received e-mail in the reply e-mail, and certainly do not teach or suggest having a user select portions of a received mail and coupling the user selected portions of the received mail with answer examples, as recited in the claimed invention. Rather, these sections of Tso merely teach to include **predefined**, context-appropriate sentences in the outgoing message **based on** the content of the input text message. In the system taught by Tso, the **entire contents** of the replay

mail is formed from the template (see column 5, line 66 – column 6, line 33). Tso only teaches to use the contents of the received e-mail to **choose the template** (see column 4, line 33 – column 5, line 53). Portions of a received e-mail are not selected by the user, and are not coupled with answer examples such that the contents of the received e-mail are inserted into the reply e-mail.

The Examiner appears to be arguing that the claimed invention is inherent in Tso. If so, this argument will also fail because in order to support an inherency argument, Tso must necessarily operate in the claimed manner (see *In re King*, 231 USPQ 136, 8 (Fed. Cir. 1986)). There is no indication in Tso that a user must pick from one or more portions of a received e-mail, and that the reply e-mail must include one or more portions of the received e-mail. Quite to the contrary, Tso merely teaches to create the outgoing text message using **templates** that are selected **based upon** the input text message (see column 4, line 32 – column 5, line 17). As presented above, the example relied on by the Examiner is not disclosed in Tso. Rather, it is a hypothetical example created by the Examiner.

Applicant maintains that Tso does not teach or suggest a system that performs the functions of: (1) requiring a user to select one or more

portions from a received mail; and (2) coupling the selected contents of the received mail with selected answer examples.

Therefore, for the reasons presented above, Applicant submits that the Examiner has misread the Tso reference and that Tso does not anticipate claims 1-7.

On page 5 of the Final Office Action, the Examiner suggests that we should amend the claims to clearly define the novel aspect of the invention. However, as presented above, the claims clearly include features that are not taught by Tso.

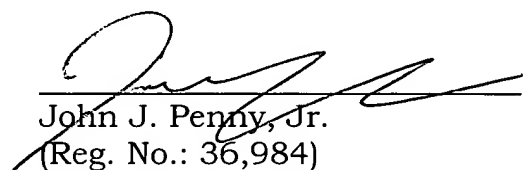
Based on the foregoing, Applicant submits that the present application is in condition for allowance and allowance is respectfully solicited. If the Examiner believes that the prosecution of this case could be expedited through a telephone interview, he is kindly invited to contact the undersigned at the phone number listed below.

Applicant believes that no additional fees are due for the subject application. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully Submitted,

Date: December 28, 2004

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